

## REMARKS

The Non-Final Office Action of December 9, 2004 has been carefully considered. Applicants respectfully acknowledge Examiner's indication of allowable subject matter, including the indication that claim 5 and its dependent claims would be allowable if rewritten in independent form. Claims 1-44, 46-48, and 56-63 are currently pending. Claims 45, and 49-55 are cancelled. Claims 1, 19, 37, and 46 are currently amended. Claims 56-63 are new. No new matter has been added by this Amendment.

Claim 1 has been amended to more particularly point out that "the guide barrel is not pivotable relative to the alignment assembly." Support for this amendment is found, *inter alia*, in Figs. 1, 7, and 8, and paragraph [0080] of the specification as-filed.

Claim 19 has been amended to more particularly point out that the guide barrel and the alignment assembly each have a length, and wherein "the guide barrel has a substantially different length than the alignment assembly." Support for this amendment is found, *inter alia*, in Figs. 1, 3A, 7, and 8 of the specification as-filed.

Claims 37 and 46 have been amended to more particularly point out that the housing of the alignment assembly is "integral with the guide barrel." Support for this amendment is found, *inter alia*, in Figs. 1, 7, and 8, and paragraph [0080] of the specification as-filed.

Claims 37 and 46 have also been amended to correct grammatical errors.

Claims 56-63 are new. Claims 56 appears as claim 5 rewritten in independent form, which Examiner indicated would be allowable. New claims 57-63 depend from claim 56, and are substantially identical to claims 6-12, which Examiner also indicated would be allowable if rewritten to depend from an amended claim 5.

No new matter has been added by these amendments.

### Rejections under 35 U.S.C. § 102

Claims 1, 13, 14,<sup>1</sup> 18, 19, 31, 32, 36-40, and 46 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,669,915 to Caspar *et al.* ("Caspar"). These rejections should be withdrawn.

Caspar discloses a drilling assembly having two sleeves 2 that are pivotable relative to one other by way of arms 3. The sleeves 2 are two separate and distinct components, and are substantially identical in size and shape.

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<sup>1</sup> Claims 13 and 14 were indicated as rejected in the Office Action Summary, but not specifically mentioned in the Detailed Action. Applicants confirmed with the Examiner via telephone that claims 13 and 14 were also rejected under § 102(b) by Caspar.

Independent claim 1 requires that “the guide barrel is not pivotable relative to the alignment assembly.” The assembly described in Caspar has two sleeves pivotable relative to one another by way of arms 3. *See id.* at 3:28-37. Therefore, Caspar does not disclose each and every element of claim 1. It is respectfully submitted that this rejection therefore should be withdrawn. Moreover, as claims 13-14, and 18 depend from claim 1, the rejections under § 102(b) directed toward those claims should similarly be withdrawn.

Independent claim 19 requires that “the guide barrel has a substantially different length than the alignment assembly.” The sleeves 2 described in Caspar “are of completely identical design.” *Id.* at 3:38-40. As such, not only does Caspar fail to describe each and every element of claim 19, Caspar teaches away from having a guide barrel having a “substantially different length” than an alignment assembly. It is respectfully submitted that this rejection therefore should be withdrawn. Moreover, as claims 31-32, and 36 depend from claim 19, the rejections under § 102(b) directed toward those claims should similarly be withdrawn.

Independent claims 37 and 46 require that the housing of the alignment assembly is “integral with the guide barrel.” The sleeves 2 of Caspar are not integral and instead are joined by pivotable connection of arms 3. Therefore, Caspar does not disclose each and every element of claims 37 or 46. It is respectfully submitted that this rejection therefore should be withdrawn. Moreover, as claims 38-40 depend from claim 37, the rejections under § 102(b) directed toward those claims should similarly be withdrawn.

#### **Rejections under 35 U.S.C. § 103(a)**

Claims 47 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caspar. Claims 47 and 48 depend from independent claim 46, which requires that the housing of the alignment assembly is “integral with the guide barrel.” As discussed above, Caspar does not disclose each and every element of claim 46. As claims 47 and 48 depend from claim 46, the rejections under § 103(a) directed toward those claims should similarly be withdrawn.

Claims 2-4, and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caspar in light of U.S. Patent No. 6,379,364 to Brace et al. (“Brace”). Claims 2-4 depend from independent claim 1, which requires that “the guide barrel is not pivotable relative to the alignment assembly.” As discussed above, Caspar fails to disclose each and every element of claim 1. Moreover, Brace fails to remedy the deficiencies of

Caspar. Therefore, the rejections under § 103(a) directed toward claims 2-4 should be withdrawn.

Claims 20-22 depend from independent claim 19, which requires that "the guide barrel has a substantially different length than the alignment assembly." As discussed above, Caspar fails to disclose each and every element of claim 19. Moreover, Brace fails to remedy the deficiencies of Caspar. Therefore, the rejections under § 103(a) directed toward claims 20-22 should be withdrawn.

### **CONCLUSION**

In view of the above amendments and remarks, it is believed that claims 1-44, 46-48, and 56-63 are in condition for allowance.

No fee is believed due for this Amendment. Please charge any fees that may be required to Jones Day deposit account no. 503013.

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Respectfully submitted,

  
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